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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/868,834	06/20/2001	Peter Beckmann	MO-6412/WW-5	6293

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EXAMINER

DICUS, TAMRA

ART UNIT	PAPER NUMBER
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1774

DATE MAILED: 08/14/2002

6

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.	Applicant(s)	
09/868,834	BECKMANN ET AL.	
Examiner	Art Unit	
Tamra L. Dicus	1774	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 29 March 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>1</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 1 recites the limitation "a sealing area" in line 2. It is unclear as to what a "sealing area" is. See pg. 3, lines 1+.

In claim 1, line 3, the phrase "screen-type" renders the claim(s) indefinite because the claims include elements not actually disclosed (those encompassed by "type"), thereby rendering the scope of the claims unascertainable. See *Ex parte Copenhaver*, 109 USPQ 118 (Bd. App. 1955).

In Claim 1 it is not clear what "feature-determining solid component" means.

In Claim 2, it is not clear what "determining solid component" means.

In Claim 5, it is not clear what "defined partial coverage" means.

In Claim 5, it is not clear what "full-tone gravure depth" means.

In Claim 10, it is not clear as to the orientation of the film with an electrically pretreated side and an outside sealing area. Furthermore, it does not make sense how the film in Claim 1 was printed in a sealing area, and in Claim 10, the film is printed outside the sealing area.

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3. In Claim 11, the limitation “the film reel” in lines 2 and 3 does not seem to further limit claim 1.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

5. Claims 1, 4, 5, 7, 9-12, and 14 are rejected under 35 U.S.C. 102(e) as being anticipated by USPN 6,159,568 to Freedman et al.

Freedman teaches a coextruded biaxially oriented polypropylene (BOPP) film with peelable sealing properties (see col. 3, lines 34-35), where the film is printed in a sealing area that has been left ink-free (printed in a printing press or mold) , further comprising a thermoplastic lacquer (a layer of ethylene vinyl acetate (EVA) copolymer covered with a lacquer) (see col. 4, line 45 and col. 5, lines 57-58) that may be a package (molded into plastic

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bottles or other containers) (see col. 1, line 5). See further Figure 1, 1A, 5, 8, and 8A. Regarding the limitation “is printed in” is a process limitation. Product-by-process claims are not limited to the manipulations of the recited steps, only the structure implied by the steps.

Patentability of an article depends on the article itself and not the method used to produce it (see MPEP 2113). Furthermore, the invention defined by a product-by-process invention is a product NOT a process. *In re Bridgeford*, 357 F. 2d 679. It is the patentability of the product claimed and NOT of the recited process steps which must be established. *In re Brown*, 459 F. 2d 531.

Regarding claims 4, 5, 7, 9, and 14 the limitation “is applied...” is a process limitation in a product claim and not patentable. The process does not change the product. See MPEP 2113. Also, regarding the drying rate, Freedman teaches at col. 5, line 56 various methods of drying such a film and therefore the rate at which the same materials are dried renders the claims equivalent.

Regarding claim 10, the limitation “is printed on...by means of...” is a process limitation in a product claim. The process notwithstanding. See MPEP 2113. Further, Freedman teaches the possibility of a polypropylene film with the option of adding lacquer as well, dried electrically (such as UV radiation), therefore having an electrically pretreated side at col. 5, lines 55-58.

Regarding claim 11, the limitation “is in the form of...” is a process limitation in a product claim and not patentable. The process does not change the product. See MPEP 2113.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2, 4, 6, and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 6,159,568 to Freedman et al., as applied to claim 1 above, and further in view of USPN 4,507,342 to Kielbania, Jr. and USPN 4,182,457 to Yamada et al.

Freedman essentially teaches the claimed invention. Freedman is silent to the addition of polyvinyl butyral (PVB). However, Kielbania, Jr. teaches a film of biaxially oriented polypropylene that may be optionally formed by a mold or heat set (a package). Additionally, Kielbania teaches suitable films in accordance with the polypropylene film to produce laminated articles that are thermoplastic film-forming, with the inclusion of adhesive paint/decorative ink polymers such as PVB (a PVB lacquer) among others of vinyl acetate and ether acrylate polymers at col. 16, line 50- col. 17, line 20, and col. 17, line 35 - col. 18, line 20. Freedman and Kielbania, Jr. are analogous art because both references are in the same field of endeavor (or address the same or similar problem with which the inventor was involved), such as polymeric multi-layer films and products. It would have been obvious to one of ordinary skill in the art to modify the invention of Freedman to include the polymer films of Kielbania for the purpose of providing a suitable vehicle for the paint or ink used in order to have surface energy for good bonding onto the polypropylene as taught by Kielbania at col. 17, lines 48-55.

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Regarding claim 2, since the lacquers of Applicant are the same, it is an inherent property that PVB or EVA will be “weakly sealable” and either both or individually may be a “determining solid component”.

Regarding claims 4 and 13, the limitation “is applied...” is a process limitation in a product claim and not patentable. The process does not change the product. See MPEP 2113. Also, regarding the drying rate, Freedman teaches at col. 5, line 56 various methods of drying such a film and therefore the rate at which the same materials are dried renders the claims equivalent.

Regarding claim 6, Yamada teaches the inclusion of saponified EVA copolymer as a film to a biaxially oriented coextruded polypropylene film at col. 6, line 24, with the option of molding or forming a package, such as a bottle. Freedman and Yamada are analogous art because both references are in the same field of endeavor (or address the same or similar problem with which the inventor was involved), such as polymeric multi-layer films and products. It would have been obvious to one of ordinary skill in the art to modify the film of Freedman with the EVA copolymer of Yamada to produce a film that acts as an oxygen-barrier that exhibits improved adhesion, interlaminar peel strength and transparency as taught by Yamada at col. 6, lines 30-66. The examiner has established a *prima facie* case of obviousness and has provided evidentiary support thereof for the rejection under 35 U.S.C. 103(a).

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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tamra L. Dicus whose telephone number is (703) 305-3809. The examiner can normally be reached on Monday-Friday, 7:00-4:30 p.m., alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on (703) 308-0449. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746-8329 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



Tamra L. Dicus
Examiner
Art Unit 1774

August 12, 2002

CYNTHIA H. KELLY
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700

